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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,759	04/08/2004	Dinesh Seksaria	00-0690 CIP [370022-00014	1878
8840	7590	04/21/2005	EXAMINER	
ECKERT SEAMANS CHERIN & MELLOTT, LLC ALCOA TECHNICAL CENTER 100 TECHNICAL DRIVE ALCOA CENTER, PA 15069-0001			FISCHMANN, BRYAN R	
			ART UNIT	PAPER NUMBER
			3618	

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/821,759	SEKSARIA ET AL.	
	Examiner	Art Unit	
	Bryan Fischmann	3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11,14,15,18-20 and 23-30 is/are rejected.
- 7) ☒ Claim(s) 2,12,13,16,17,21,22,31 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7-20-04</u> . | 6) <input type="checkbox"/> Other: _____ |

Specification

1. The abstract of the disclosure is objected to because of the following:
 - A) The abstract uses legal terms such as "comprises" (see MPEP 608.01(b)).
2. The disclosure is objected to because of the following:
 - A) A "blank space" is missing between the word "wire" and a "parenthesis" on line 2 of paragraph 0038.

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The oath or declaration is not signed by the inventors.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features that allow the cover plate to be removably attached to the U-frame member as set forth in claims 18-20 must be shown or the features canceled from the claims. No new matter should be entered.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention.

A) Claim 14 recites the limitation "said U-frame arms". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3618

8. Claims 23, 24 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Sauri, US Patent 5,468,038.

Sauri teaches a method (see comments below) for utilizing a tailgate extension apparatus comprising the steps of:

opening a vehicle tailgate into a substantially horizontal position (Figure 2);

extending a U-frame member (134, 136 and 144) from a storage position within said tailgate to a position outside of said tailgate (Figure 4); and

locking said U-frame member into an operative position (Figure 5) by means of a plurality of side braces (126, 128 and 152).

Regarding claim 23 and claims that depend from claim 23, it is the Examiner's position that Sauri anticipates the claimed method because the method is inherently disclosed. The rationale for this inherency is that the prior art device, in its normal and usual operation, would necessarily perform the claimed method. See MPEP §2112.02. See *In re King*, 801 F.2d 1324, 1326; 231 USPQ 136, 138 (Fed Cir 1986).

Regarding claim 24, see "hinge elements" attached to 144 on Figure 4.

Regarding claim 30, see reference number 152 and Figure 5.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3618

10. Claims 1, 3-11, 14, 15, 23-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glickman, et al, US Patent 6,454,338, in view of Pool, III, US Patent 5,816,638.

Glickman teaches an extension apparatus for a vehicle tailgate, comprising:
a U-frame member (14 and 18), said member being slidably removable from an interior portion of said vehicle tailgate (Figure 2).

Glickman fails to teach how the U-frame member is supported in the "extended" positions of Figures 2-4.

However, Pool teaches an extension apparatus for a vehicle tailgate comprising a plurality of side braces (70 – Figure 2) adapted to lock an extension member in a plurality of operative positions (Figures 2 and 5). A plurality of side braces attached to a vehicle extension member, such as shown on Figures 2 and 5 of Pool, is necessary in order to prevent the acceleration of gravity from causing unwanted downward movement of the extension member when in the positions such as shown on Figures 2 and 5 of Pool, or Figures 2-4 of Glickman.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize side braces on the U-frame member of Glickman, as taught by Pool.

Regarding claims 3 and 25, see Figure 4 of Glickman.

Regarding claims 4 and 26, see Figure 2 of Glickman.

Regarding claims 5 and 28, see Figure 3 of Glickman.

Art Unit: 3618

Regarding claim 6, the U-frame member of Glickman and the tailgate of Glickman are "linked" by the side braces of Pool, via members 20 of Pool.

Regarding claims 7 and 8, note also that it is considered within the skill level of one of ordinary skill in the art to select a material based on its intended use. See *In re Leshin*, 125 USPQ 416. Metal, such as aluminum is an advantageous in that it is relatively strong, relatively lightweight and resists corrosion.

Regarding the term "extrusion" in claim 7 and "hydroformed" in claim 9, note that Section 2113 of the MPEP recites "the patentability of a product does not depend on its method of production". Section 2173.05(p) of the MPEP also recites "A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable...so long as it is clear that the claim is directed to the product and not the process". From this, the method of how the U-frame is formed is not considered germane, since the claim is directed to an apparatus. Therefore, the recitation of "extrusion" in claim 7 and "hydroformed" in claim 9 has been given patentable weight only to the extent that the U-frame in the prior art is capable of being extruded, or hydroformed. It is the Examiner's position that the prior art is capable of being manufactured by extrusion, or hydroforming. Once this prima facie case has been established, the burden shifts to the applicant to show that the prior art structure is not capable of being formed by hydroforming, or extrusion.

Regarding claims 10 and 11, the Examiner takes Official Notice that vehicle steps are known to have a "knurled" or "non-skid" surface to improve traction. This may

Art Unit: 3618

be seen on vehicles such as "pick-up trucks" or "SUV's" which have steps in the "rocker panel area" to facilitate access to the passenger compartment of these vehicles, as they have a relatively high ground clearance, making entry into the passenger compartment of these vehicles more difficult. The knurled, or non-skid surface on these steps facilitates traction, particularly in wet weather conditions.

Regarding claims 14 and 15, see lines 52 and 53 of column 2 and Figures 1 and 2 of Glickman.

Regarding the method of recited in claim 23 and claims that depend from claim 23, it is the Examiner's position that it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the claimed method taught by Glickman, as modified by Pool. Because the prior art discloses all the structure necessary to perform the claimed functions, one of ordinary skill in the art would find the claimed method to be an obvious step in light of the disclosed structure. See MPEP §2112.02. See also *In re King*, 801 F2d 1324, 1326; 231 USPQ 136, 138 (Fed Cir 1986).

11. Claims 18-20, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glickman, et al, US Patent 6,454,338 and Pool, III, US Patent 5,816,638, as applied to claims 1, 26 and 28, and further in view of McCormack, US Patent 5,605,367.

The combination extension apparatus of Glickman fails to teach a cover plate attached to the U-frame member.

Art Unit: 3618

However, McCormack teaches a cover plate (50) that is adapted to be attached (Figure 1) to a U-frame member (24 and 34) of a tailgate. A cover that is adapted to be attached to a U-frame member of a tailgate is advantageous in that certain types "long slender loads", such as lumber, tubing, piping, etc., may not be adequately retained by the U-frame member of Glickman.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a cover plate on the combination U-frame member of Glickman, as taught by McCormack.

Regarding the method of claims 27 and 29, see the comments regarding method claim 23 in the "103 portion" of this Office Action.

Allowable Subject Matter

12. Claims 2, 12, 13, 16, 17, 21, 22, 31 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3618

Thayer, Kirchhoff, Leitner, Chumley, et al – teach tailgate extensions

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (571) 272-6694. The examiner can normally be reached on Monday through Friday from 9:00 to 5:30.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis, can be reached on (571)272-6914. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 4-16-5
BRYAN FISCHMANN
PRIMARY EXAMINER